

Appl. No. 10/024,959
Amdt. dated February 6, 2004
Reply to Office Action of October 6, 2003

PATENT

REMARKS/ARGUMENTS

This Amendment is responsive to the Office Action mailed on October 6, 2003. A petition for a 1-month extension of time is attached so that the due date is to and including February 6, 2004. Entry of this Amendment is respectfully requested.

Prior to this Amendment, claims 1, 3-19, and 21-25 were pending. In this Amendment, claims 1 and 3-19 are canceled, claims 21-25 are not amended, and claims 26-30 are added so that claims 21-30 are pending and are subject to examination.

Support for new claims 26-30 can be found throughout the specification, claims, and drawings as originally filed. Exemplary support can be found as follows: claim 26 (p. 9, lines 29-32); claim 27 (p. 10, lines 15-17); claim 28 (p. 11, lines 28-29); claim 29 (page 14, line 13); and claim 30 (page 14, lines 10-22).

In the Office Action, claims 1 and 3-19 are rejected as obvious over Comisar et al. (U.S. Patent No. 3,944,788) and Graft, III (U.S. Patent No. 5,278,753).

In response to the Office Action, claims 1 and 3-13 are canceled to expedite the prosecution of this application. Applicants do not admit that the rejection based on Comisar et al. and Graft, III is proper by this cancellation of claims.

Claims 21-25 are rejected as obvious over Comisar et al., Graft, III, and Brigida et al. (U.S. Patent No. 5,313,051). This rejection is traversed.

The Examiner acknowledges that Comisar et al. and Graft, III, fail to disclose using a first antenna and a second antenna. However, the Examiner alleges that Brigida et al. discloses an antenna and an overlay assembly 704 having an antenna. According to the Examiner:

In view of Brigida et al's teachings, it would have been obvious for a person of skill in the art at the time the invention was made to modify the teachings of Comisar et al as modified by Graft, III to include antenna elements in the overlay and in the stylus to facilitate communication between the stylus and the device. Such modification would make the system more effective by providing wireless communication means and would facilitate voters' interaction with the device. Therefore, it would have been

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an obvious extension as taught by Comisar et al as modified by
Graft, III. (emphasis added.)

This rejection is traversed.

I. The alleged motivation to combine was improperly taken from Applicants' own specification and not the prior art as required by § 103.

The obviousness rejection is improper, since the motivation to combine Brigida, et al. with Comisar et al. and Graft, III was improperly taken from Applicants' own specification and not the prior art as required by § 103. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). MPEP § 2143.01. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and must not be based on applicant's disclosure. *In re Vaecht*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). MPEP § 2412. Here, the alleged motivation that one would have modified Comisar et al.'s voting apparatus with the antennas in Brigida et al. to "*make the system more effective by providing wireless communication means and [to] facilitate voters' interaction with the device*" is not suggested by the prior art as required by § 103. As noted by the Examiner, Comisar et al. and Graft, III both fail to teach or suggest antennas at all, so these references cannot suggest the alleged motivation. Brigida et al. also does not suggest the alleged motivation. Brigida et al. is entitled "paperless parcel tracking system" and relates to parcel delivery systems (see c. 1, 1. 5-10), and not voting machines. Rather, the *only* place of record that suggests that antennas can facilitate voters' interactions is at page 8, lines 18-26 of the present specification. Since the motivation to combine Brigida et al. with Comisar et al. and Graft, III was taken from Applicants' own specification and not the prior art as required by § 103, obviousness has not been established. *Should the Examiner maintain the rejection based on the combination of Brigida et al. and Comisar et al., Applicants request that the Examiner point out where the prior art suggests this alleged motivation.*

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II. Nothing in the prior art suggests that Brigida et al.'s wireless communication means would be "more effective" than the mechanism disclosed in Comisar et al.

Nothing in Brigida et al. indicates that the antennas described therein are "more effective" than the type of mechanism described in Comisar et al. As stated previously, Comisar et al. describes an electrical sensor matrix having a plurality of electrical contacts. The plurality of electrical contacts includes row contact strips and column contact strips. A stylus is inserted through perforations in the contact strips to make electrical contact with one row strip and one column strip, and to simultaneously punch a ballot card (see, c. 2, l. 50-60). The allegation that one would have been led to have modified Comisar et al.'s apparatus with antennas to "make the system more effective" is simply not supported by the prior art. Wireless communication mechanisms are generally less reliable than hardwired communication mechanisms. Accordingly, contrary to the Examiner's position in the Office Action, one would not have been led to modify Comisar et al.'s apparatus with antennas to "make the system more effective".

III. Obviousness has not been established since Brigida et al. and Comisar et al. teach away from each other, and any combination thereof would have been based on improper hindsight in view of Applicants' disclosure.

Applicants also respectfully submit that Brigida et al. and Comisar et al. teach away from each other, and are therefore not combinable. It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). MPEP § 2145. Here, Comisar et al. clearly discourages using totally electronic machines (see c. 1, l. 55 to c. 2, l. 15) and requires the use of a printed ballot or paper medium as a back up record of voter selections (c. 3, l. 30-40). In direct contrast, Brigida et al. is entitled "paperless parcel tracking system" and states that paper is "difficult and expensive to handle both in labor and storage costs" (c. 1, l. 15-20). While Brigida et al. discourages using paper, while Comisar et al. requires the use of paper. Since Comisar et al. and Brigida et al. teach away from each other, obviousness has not been established.

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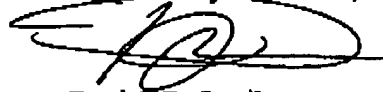
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Given the completely contrary objectives in *Comisar et al.* and *Brigida et al.*, one skilled in the art would not have combined these references unless they had had the benefit of viewing Applicants' disclosure first using improper hindsight. "It is difficult but necessary that the decisionmaker forget what he or she has been taught . . . about the claimed invention and cast the mind back to the time the invention was made (often as here many years), to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art." *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983). Put another way, absent improper hindsight, one viewing "only" *Comisar et al.* and *Brigida et al.* would not have combined these references as in the pending obvious rejection, since (1) *Comisar et al.* and *Brigida et al.* are in completely different fields, and (2) *Comisar et al.* and *Brigida et al.* explicitly teach away from each other.

CONCLUSION

In sum, Applicants believe that there are many more reasons why one would consider the claims in this application allowable, rather than not allowable. The Examiner is requested to call the undersigned if a teleconference would expedite the prosecution.

Respectfully submitted,



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